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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,094	03/17/2000	Frank J. Montero	VSD-201-I-CON	3570
24972	7590	02/22/2005	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			POLLACK, MELVIN H	
666 FIFTH AVE			ART UNIT	PAPER NUMBER
NEW YORK, NY 10103-3198			2145	

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/528,094	MONTERO, FRANK J.	
	Examiner	Art Unit	
	Melvin H Pollack	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 September 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 417-422 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 417-422 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 September 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/13/00</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/30/04 have been fully considered but they are not persuasive. The reasons are provided below.
2. In the response to the last office action, the applicant changed the scope of the claims by adding "determining a domain associated with host server" to all independent claims. As a result, a final amendment is necessitated even if the examiner provides a new art rejection. The examiner acknowledges that no new matter has been added by this amendment.
3. The examiner accepts the new title, abstract, and drawings.
4. The examiner has reviewed the prior application. In light of applicant's remarks, the IDS is determined to be properly submitted, and the references have been considered.
5. In response to applicant's argument that Belifore is nonanalogous art (P. 2, lines 22-30), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the purpose of Belifore (abstract) is to handle invalid resources, i.e. any text entered which is determined not to have a valid URL format (col. 2, lines 13-20), including cases upon which parts of a URL is missing (col. 2, lines 55-60) and in cases upon which only a keyword is used (col. 2, lines 25-35). If a host name is entered in the text box, Belifore is designed to resolve the host name into a valid URL, either by appending various text strings or by searching for the host name. While it is concerned with other problems, i.e. handling search phrases such as "business laptops," the

providing of a complete URL based upon a host name such as “IBM” is clearly pertinent to Belifiore and within the field of the applicant’s endeavor of resolving incomplete URLs.

6. The applicant is further reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

7. As for whether Belifiore teaches, explicitly or implicitly, the added method of “contextually determining a domain associated with said host server” (i.e. determining www.ibm.com from ibm) when completing the URL, a discussion of Belifiore is necessary. Please note that “contextually determining” may be read broadly to determine any form of determination, be it searching or simply recognizing that certain parts are missing.

8. Belifiore performs two methods for resolving an incomplete URL. The first method is the cited method of attempting to construct the URL from processed text (Fig. 7, #91). The example provided is to add a scheme (http) to the terms (col. 5, lines 40-45; col. 6, lines 15-30), but other methods would obviously be used due to heuristics and tracking of previously entered URLs within a registry (col. 3, lines 65 – col. 4, line 5).

9. There is, however, a second method of resolving a URL in which the terms are sent to a valid search engine (Fig. 7, #94) in which the search engine produces the best results (Fig. 8A, #96) and determining the most likely web page (Fig. 8B, #102). That is, if ibm is entered,

Belfiore will search the term “ibm” and determine the best URL, in this case www.ibm.com, which easily fits within the definition of contextual determination of the domain. Hence, Belfiore clearly teaches the limitations as currently drawn.

10. Applicant’s also allege that Belfiore does not expressly teach or disclose using “a function of a probability distribution of the number of host servers in a particular domain.” The examiner interprets this phrase broadly to mean that some function is utilized to determine which url is the best using some functionality. That is, if the host name was whitehouse, Belfiore would determine that the user would prefer www.whitehouse.gov rather than www.whitehouse.com, aided by the probability distributions inherent in search engines to try top determine the relevant link. If there is a particular technique of function used to perform this aspect of the invention, the applicant is invited to amend the claims in order to reflect this particular aspect.

11. For the reasons above, the original rejection is maintained and is therefore made final.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 417, 418, 420, and 421 are rejected under 35 U.S.C. 102(e) as being anticipated by Belfiore et al. (6,009,459).

14. For claim 417 and 420, Belfiore teaches a method (see abstract) of connecting a terminal (Fig. 3, #30) to a host server (Fig. 3, #34) on the Internet (col. 1, lines 15-27; Fig. 3, #32) in response to an incomplete uniform resource locator (col. 1, lines 5-10; col. 2, lines 10-20), wherein said terminal has a monitor (Fig. 3, #48) and an input device (Fig. 3, #50), the method comprising the steps of:

- a. Entering a host name (col. 1, lines 45-55) by a user (Fig. 4, #60) corresponding to said host server on said input device (Fig. 10A) to provide said incomplete uniform resource locator (Fig. 7, #92-94);
- b. Contextually determining remaining components of said incomplete uniform resource locator (col. 2, lines 20-60; see above) as a function of said host server (Fig. 8B).

15. For claims 418 and 421, Belfiore teaches determining a domain of said host server as a function of a probability distribution of the number of host servers in a particular domain (col. 3, line 60 – col. 4, line 40; col. 7, lines 5-20; see above).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 419 and 422 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belfiore as applied to claims 417 and 420 above, and further in view of Mantha et al. (6,163,779).

18. For claims 419 and 422, Belfiore does not expressly disclose that said monitor includes a plurality of clickable buttons, each of said plurality of clickable buttons corresponding to one component of a uniform resource locator. Belfiore does teach a variety of GUIs (col. 7, line 66 – col. 8, line 25). It is considered in the art that a TV with remote and set-top box for internet access is functionally equivalent to a PC with monitor and input device. Mantha teaches a system (see abstract) that uses such a device (Fig. 2A-2D) and furthermore includes said clickable buttons (Fig. 2D, #144-160; col. 5, lines 5-27). At the time the invention was made, one of ordinary skill in the art would have used a Mantha “Web appliance” as a Belfiore client in order to decrease the hardware costs (col. 4, lines 60-65).

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
16 February 2005



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